

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

MAR 29 2006

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte KLEIN A. RODRIQUES, MARTIN CROSSMAN  
and SUSANNE H. GOODSON

Application No. 10/072,402

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on February 13, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On July 22, 2004, the examiner entered a Final rejection.

On January 5, 2005, appellants filed a Notice of Appeal.

On July 8, 2005, appellants filed an Appeal Brief. In response to appellants' Appeal Brief, the examiner mailed an Examiner's Answer on September 21, 2005. A review of the Examiner's Answer reveals that on page 6 of the Answer, the examiner entered a new

ground of rejection of claims 13, 15-20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Arfaei, and a new ground of rejection of claims 7-13 and 15-25 under 35 U.S.C. § 103 as being unpatentable over Rodrigues. Therefore, based on a review of this application, it is not clear whether the examiner has maintained the same rejections on appeal, or whether the examiner has entered new grounds of rejection.

According to MPEP § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

Therefore, if the examiner has entered new grounds of rejection, the examiner must clarify these rejections in a Supplemental Examiner's Answer. In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Accordingly, it is

ORDERED that the application is returned to the examiner to either:

- (1) reopen prosecution to address the new ground of rejection, or
- (2) make note of the new ground of rejection in a corrected Examiner's Answer and to obtain approval from a TC Director or appropriate designee; and
- (3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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